

Serial No. 10/708,834
Attorney Docket No. 60655.9700

REMARKS

Applicants reply to the Office Action mailed on January 30, 2006, within the shortened statutory period for reply. Claims 1-12 were pending and the Examiner rejects claims 1-12. Applicants amend various claims, add new claims 13-16, and address the Examiner's remarks. Thus, claims 1-16 are now pending in the application. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

Double Patenting

Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/708,824 in view of Maes, et al. 6,016,476 ("Maes"). While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this provisional non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

Claim Rejections

§112 Rejections

Claims 1-12 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the Examiner indicates that the phrase "authorizing said transaction that violates an established rule to proceed upon verification of the proffered biometric sample" is unclear. To clarify, Applicants amend claim 1 to recite "authorizing said transaction to proceed notwithstanding said established transaction limitation upon verification of the said proffered biometric sample." Similarly, Applicants amend claim 1 to clarify that it is a "biometric sample" that is detected.

Serial No. 10/708,834
Attorney Docket No. 60655.9700

Regarding claim 5, Applicants have omitted the redundant instance of the term "detecting."

Regarding the phrase "finite number" in claim 6, Applicants amend claim 6 to clarify that the detecting may include "receiving a limited number" of biometric samples.

Regarding claim 7, Applicants amend the claim to clarify that the "logging" is in addition to the "detecting."

Regarding claim 8, Applicants have omitted the redundant instance of the term "detecting."

Accordingly, Applicants request withdrawal of the rejection of these claims under §112.

§103(a) Rejections

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kita 6,703,918 ("Kita") and in view of Maes, et al. 6,016,476 ("Maes"). Applicants respectfully traverse these rejections.

The transaction limitations disclosed in Maes are not overridden by validation of a biometric sample, but are merely loaded into a digital certificate. Thus, while Kita and Maes may disclose various transaction and biometric security technologies, neither Kita, Maes, nor any combination thereof, disclose or suggest at least a method comprising "notifying a user to proffer a biometric sample to override said transaction limitation; . . . and authorizing said transaction to proceed notwithstanding said transaction limitation upon verification of said proffered biometric sample," as recited in amended independent claim 1.

Accordingly, Applicants assert that claim 1 is patentable over the cited references. Similarly, claims 2-12 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that these claims are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-12.

Serial No. 10/708,834
Attorney Docket No. 60655.9700

NEW CLAIMS 13-16

New claims 13-16 variously depend from claim 1 and contain all of the respective elements thereof. Therefore, Applicants assert that new claims 13-16 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

CONCLUSION

Applicants respectfully submit that the pending claims (16 total, 1 independent) are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: Apr. 28 2006

By: Kirk Dorius
Kirk Dorius
Reg. No. 54,073

SNELL & WILMER L.L.P.
400 E. Van Buren
One Arizona Center
Phoenix, Arizona 85004
Phone: 602-382-6544
Fax: 602-382-6070
Email: kdorius@swlaw.com

AmExp No. 200501420

6

BEST AVAILABLE COPY